

REMARKS

The Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

I. Status of Claims

Claim 4 has been cancelled. Claim 1 has been amended to recite a method of producing propylene, wherein hydrogen peroxide is reacted with propylene. Claims 2-3, and 5-6 have been amended to correct minor informalities and dependency. No new matter has been introduced.

I. 35 U.S.C. § 112, 1st Paragraph, Rejections

Claims 1 and 5, and their dependent claims, have been rejected under 35 U.S.C. § 112, first paragraph. The Examiner has alleged that the specification has not provided enablement for any and all peroxides and any and all alcohols, and thus it does not enable a person skilled in the art to use the invention commensurate in scope with these claims. The Applicants respectfully traverse these rejections.

Applicants believe “[a]ny analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention.” MPEP, 8th ed. Rev.2, 2164.01. See also *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984).

The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. sub nom.*, *Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404.

As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). A person of skill in the art would be able to practice the claimed invention using methods within the specification.

Without acquiescing to the grounds of rejection, claim 1 has been amended to recite that **hydrogen peroxide** is used as the peroxide to react with propylene. Additionally, Applicants submit a Rule 132 Declaration from Mr. Hiroaki Abekawa to establish that a wide variety of solvents are compatible with the methods claimed in this application; see Example 1 of the instant specification and the methods section of the Declaration. As the declaration demonstrates, a wide variety of solvents, including methanol, 2-propanol, and acetone can be used with the currently claimed method to produce products with comparable properties to the products made with tert-butyl alcohol ("tert-butanol"). Since a person of skill in the art would be able to practice the methods provided in this application with a variety of solvents known in the art, the claims are enabled by the specification. See *In re Buchner* and *In re Fisher*. Applicants request reconsideration and withdrawal of the rejection.

CONCLUSION

The Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, the Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By Benjamin A. Berkowitz

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 295-4620
Facsimile: (202) 672-5399

Benjamin A. Berkowitz
Attorney for Applicants
Registration No. 59,349